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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,754	12/05/2003	Gregory J. Bakos	END5244USNP	3187
27777 7590 05/02/2008 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER FOREMAN, JONATHAN M				
ART UNIT		PAPER NUMBER		
3736				
MAIL DATE		DELIVERY MODE		
05/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/729,754

**Applicant(s)**

BAKOS ET AL.

**Examiner**

JONATHAN ML FOREMAN

**Art Unit**

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007 and 21 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 20 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 20 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Invention I in the reply filed on 1/21/08 is acknowledged. The traversal is on the ground(s) that the claims are not independent and distinct. This is not found persuasive because MPEP 806 states that a restriction requirement may be proper if the claimed invention is independent or distinct.

The requirement is still deemed proper and is therefore made FINAL.

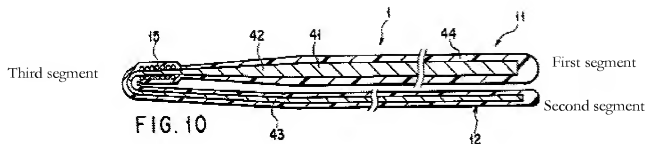
### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 – 17, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application No. 2002/0087100 to Onuki et al. in view of US Patent No. 5,389,073 to Imran.

In regards to claims 1 – 17, 20 and 24, Onuki et al. disclose a guide wire structure (Figure 10) for facilitating the positioning of a surgical device in the gastrointestinal tract of a patient including a unitary wire (41) having a flexible elongate first segment, a flexible elongate second segment, and a third segment disposed intermediate the first and second segments.



Onuki et al. disclose at least one of the first, second, and third segments having a circular cross-section or a non-circular cross-section [0118]. Onuki et al. disclose a visual indicator including a marking associated with one of the segments [0109]. Onuki et al. disclose a sleeve (44) encircling each of the first and second segments. The sleeves are visual distinguishable as a result of the size and shape of the sleeve. The combined length of the first segment, the second segment, and the third segment is between about 20 feet [0127][0111]. The first segment has a length of at least about 6 feet and a generally circular cross-section having a diameter of between about 0.011 inch to about 0.035 inch [0111]. The first and second segments are slideably received by a channel associated with an endoscope having a distal end [0114]. The first, second and third segments define a loop distally beyond the distal end of the endoscope (Figure 6). The first and second segments are independently slideably relative to the endoscope which would allow varying of the loop geometry. In use the third segment is bent and provides an elastic hinge and is positioned distally relative to the first and second segments. The third segment is formed of an elastic material [0111]. Onuki et al. fails to disclose the third segment having a bending moment of inertia less than a bending moment of inertia of the first or second segment nor a tapered segment between the first and second segments to the third segment. However, Imran discloses a guide wire structure (Figure 6) including first segment (121), a second segment, and a third segment (126) disposed intermediate the first and second segments, tapered segments between the first, second and third segments, wherein the third

segment having a bending moment of inertia less than a bending moment of inertia of the first or second segment (Col. 4, lines 64 – 67) and a diameter of between 0.005 inch and about 0.010 inch (Col. 3, line 12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the third segment as disclosed by Onuki et al. to have a bending moment of inertia less than a bending moment of inertia of the first or second segment as taught by Imran to ensure that the guide wire bends at the desired position (Col. 5, lines 1 – 5).

#### ***Response to Arguments***

4. Applicant's arguments filed 10/18/07 have been fully considered but they are not persuasive. Applicant asserts that Onuki teaches away from the conclusions drawn by the Examiner. However, the Examiner disagrees. Because the first and second segments are independently slideable relative to the endoscope, the loop geometry can be varied. This is an inherent characteristic of the guide wire. Additionally, because the wire is formed of an elastic material [0111], the third segment is an elastic hinge.

#### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./  
Examiner, Art Unit 3736

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736